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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,835	09/23/2003	Kent S. Greenawalt	2-5056-087	8724
803	7590	12/28/2004	EXAMINER	
STURM & FIX LLP 206 SIXTH AVENUE SUITE 1213 DES MOINES, IA 50309-4076			DAHBOUR, FADI H	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,835

Applicant(s)

GREENAWALT ET AL 

Examiner

Fadi H. Dahbour

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/01/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The Examiner acknowledges Applicant's submission of the amendment filed on 10/01/04. Claims 1-4 are now pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by White ('520).

White discloses an apparatus for obtaining measurements for constructing corrective orthotics and footwear (Figs.1-67), comprising at least one flatbed scanner (Fig.3A), a computer operatively attached to the scanner (Fig.2), and software operatively attached to the computer for the computer for organizing scanned foot data for making measurements and observations of the scanned foot data (see "software" in line 46 of col.1, and in line 15 of col.9, and in line 31 of col.16, also see Figures 1-5) for the purpose of constructing corrective orthotics and footwear (see "TO MANUFACTURE CUSTOM FOOTWEAR AND FOOTWEAR PRODUCTS" in Fig.1, also see "custom footwear products could include items such as custom fit insoles, heel cups, metatarsal support, volume adjustment shims, and the like...custom footwear could include boots, shoes, and other various forms of footwear" in lines 41-45 in col.3 of White, also see, "custom orthotics, custom shoes and custom sandals, all referred to herein as "corrective orthotics" " on page 1 of applicant's specification).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over White ('520) in view of Baum.

6. White discloses a method for obtaining measurements for constructing corrective orthotics using at least one flatbed scanner and one computer (Figures 1-67), comprising taking at least one scan of a patient's foot, the patient with at least one foot on the at least one flatbed scanner (Fig.3A), using measurements (see "for measuring" in line 59 of col.1), observation (see "visual display" in line 64 of col.1), and color differences from the scan and computer (see "may include assigning color hues" in lines 4-5 of column 2, also see "assigning...color values" in lines 14-15 of column 2) to obtain the measurements necessary for constructing corrective footwear (see "TO MANUFACTURE CUSTOM FOOTWEAR AND FOOTWEAR PRODUCTS" in Fig.1, also see "custom footwear products could include items such as custom fit insoles, heel cups, metatarsal support, volume adjustment shims, and the like...custom footwear could include boots, shoes, and other various forms of footwear" in lines 41-45 in col.3 of White, also see, "custom orthotics, custom shoes and custom sandals, all referred to herein as "corrective orthotics" " on page 1 of applicant's specification), including constructing corrective orthotics by forming one or more pieces of material into a corrective arch support, orthotic, shoe or sandal (see "custom footwear products could

include items such as custom fit insoles, heel cups, metatarsal support, volume adjustment shims, and the like... custom footwear could include boots, shoes, and other various forms of footwear” in lines 41-45 in column 3 of White, also see, “custom orthotics, custom shoes and custom sandals, all referred to herein as “corrective orthotics” ” on page 1 of applicant’s specification) while employing the measurements to accommodate the arch support to the foot from which the scan was made (see “the user may choose to select fit aids... such as... arch support” in lines 23, 24, 28, 29 of col.14), wherein the measurements are made using a mechanical device, electronic device, and/or calculations based on color variations (Figs 1-5).

White, as described above, discloses all the features claimed except standing. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have standing, in the method of White, because Baum teaches that it is possible to scan a person’s foot which is non-weight bearing, partial weight bearing, or fully weight bearing (see lines 46-48 in column 6 of Baum).

Response to Arguments

7. Applicant argues that White does not mention “standing”. However, this is moot in view of the new ground(s) of rejection.


8. Applicant argues that White does not mention “corrective” footwear. However, White discloses such; (see “custom footwear products could include items such as custom fit insoles, heel cups, metatarsal support, volume adjustment shims, and the like... custom footwear could include boots, shoes, and other various forms of footwear” in lines 41-45 in column 3 of White, also see, “custom orthotics, custom shoes and custom sandals, all referred to herein as “corrective orthotics” ” on page 1 of applicant’s specification).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadi H. Dahbour whose telephone number is 571-272-4792. The examiner can normally be reached on M-F, 9am-5:30pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett, can be reached on (571) 272-4791.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Fadi H. Dahbour
Examiner
Art Unit 3743